



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,507	02/08/2002	Rodney Davis	2002301	5975
30086 7590 01/19/2007 ROBERT A. HUNTSMAN 5465 EAST TERRA LINDA WAY NAMPA, ID 83687-1515				
EXAMINER ARAUQUE JR, GERARDO				
ART UNIT		PAPER NUMBER		
3629				
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE		DELIVERY MODE
3 MONTHS		01/19/2007		PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.	Applicant(s)	
10/073,507	DAVIS ET AL.	
Examiner	Art Unit	
Gerardo Araque Jr.	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. In regard to **claim 53**, applicant discloses a product and process in the same claim. In ex parte Lyell at 1552, the court stated "A claim such as those before us cannot be both method and apparatus. It must be clear from [the] wording [of the claim] that it is drawn to one or the other of [the] mutually exclusive statutory classes of invention [set for in 35 USC 101]. A method or process [claim] is an act or a series of acts and from the standpoint of patentability must distinguish over the prior art in terms of steps, whereas a claim drawn to apparatus must distinguish in terms of the structure. This is so elemental as not to require citation of authorities." In the present case, the applicant discloses:

- a. a vendor monitor (**apparatus**);
- b. wherein the compliance status for each monitored contract terms is determined by querying each machine and testing each monitored contract term associated with said machine for compliance (**method**).

Further still, if the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 USC 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter. In the present case, the applicant discloses:

a. one or more managed sophisticated office machine, each machine having monitored contract terms, **each machine further having an associated vendor responsible for complying with the monitored contract terms.**

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 53 – 76** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. In regards to **claim 53**, applicant discloses a product and process in the same claim. In ex parte Lyell at 1551, the Board (BPAI) sustained the examiner's rejection under 35 USC 112, 2nd paragraph, stating "we much agree with the examiner that a single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention." In the present case, the applicant discloses:

- a. a vendor monitor (**apparatus**);
- b. wherein the compliance status for each monitored contract terms is determined by querying each machine and testing each monitored contract term associated with said machine for compliance (**method**).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 47 and 48** are rejected under 35 U.S.C. 102(e) as being anticipated by **Saxon (US PGPub 2001/0039522 A1)**.

3. In regards to **claim 47**, **Saxon** discloses a system for acquiring an inventor of sophisticated office machines comprising:

a needs analyzer, the needs analyzer further includes a needs receiver, the needs receiver is capable of receiving needs input by a consumer (**Page 1 ¶ 5 L. 1 – 12**),

wherein the needs analyzer analyzes the needs input by the consumer and converts said needs into a list of vendor specifications (**Page 1 ¶ 5 L. 1 – 12**),

a consultant interface, the consultant interface is capable of interacting with a consultant, the consultant interface is software couple to the needs analyzer wherein the consultant may review and modify the vendor specification list produced by the needs analyzer (**Page 1 ¶ 7 L. 11 – 13**).

4. In regards to **claim 48**, **Saxon** discloses further including a vendor quote requester wherein the vendor quote requester converts the list of vendor specifications

into vendor-specific requests for quotations and prepares input screens reflecting each request for quotation (**Page 1 ¶ 5 L. 12 – 20**).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 53 – 55, and 66** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Saxon (US PGPub 2001/0039522 A1)**.

7. In regards to **claim 53**, **Saxon** discloses a system for managing an inventory of sophisticated office machines comprising:

one or more managed sophisticated office machine (**Page 1 ¶ 5 – 7**), each machine having monitored contract terms, each machine further having an associated vendor responsible for complying with the monitored contract terms,

a vendor monitor (**Page 2 ¶ 17**), wherein compliance status for each monitored contract term is determined by querying each machine and testing each monitored contract term is determined by querying each machine and testing each monitored contract term associated with said machine for compliance,

a vendor manager (**Page 1 ¶ 7**), the vendor manager able to communicate with said vendors, wherein each said associated vendor is automatically notified of compliance status.

8. In regards to **claim 54**, **Saxon** discloses further including a real-time reporter (**Page 2 ¶ 16 – 17, 21**), the vendor monitor further includes a productivity tracker and a cost tracker (**Page 2 ¶ 16 – 17, 21**),

wherein the productivity tracker maintains useful productivity-related statistics, the cost tracker maintains useful cost-related statistics (**Page 2 ¶ 16 – 17, 21**),

wherein said statistics are reported by said real-time reporter on demand (**Page 2 ¶ 16 – 17, 21**).

9. In regard to **claims 55 and 66**, **Saxon** discloses further including a contract writer, wherein the contract writer produces a contract specifying monitored contract terms for each machine (**Wherein Saxon discloses that a remote station is loaded with accounting software which keeps track of inventory, work in progress, prices, and etc. Further still, Saxon also discloses the creation of invoices/purchase orders as well. The examiner would like to note that invoices/purchase orders are types of contracts, i.e. an invoice/purchase order would contain an agreement of what would be purchased and the cost of the purchase, which must be paid for**),

wherein the monitored contract terms produced by said contract writer are monitored by said vendor monitor and said compliance status is reported by said real time reporter (**Page 2 ¶ 16 – 17, 21**).

10. **Claims 49, 50, 51, 52, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 67, 68, 69, 70, 71, 72, 73, 74, 75, and 76** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Saxon (US PGPub 2001/0039522 A1) in view of Keane et al. (US PGPub 2004/0046788 A1).

11. In regards to **claim 49**, **Saxon** is discussed above, but fails to teach further including a vendor interface, wherein one or more vendors review the requests for quotations and prepare and submit bids in response to said requests for quotations.

However, Keane teaches that the customer, whom instructs the system to search for printing firms to fulfill the customer's request (bidding), inputs predetermined requirements into the system. It would have been obvious that in the event that multiple bidders are able to fulfill the predetermined requirements set by the customer that the system would require user input, by the customer, to make the final decision of who should carryout the request (**Pg. 5 ¶ 52 L. 2 – 4, ¶ 55 L. 1 – 7**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **Saxon** in view of the teachings of Keane to include a vendor interface at the remote stations in order to have the vendors submit bids.

12. In regards to **claims 50 – 52**, **Saxon** to include a contract writer, wherein the contract writer produces a contract specifying monitored contract terms for each machine (**Wherein Saxon discloses that a remote station is loaded with accounting software which keeps track of inventory, work in progress, prices, and etc. Further still, Saxon also discloses the creation of invoices/purchase orders as well. The examiner would like to note that invoices/purchase orders are types of contracts, i.e. an invoice/purchase order would contain an agreement of what would be purchased and the cost of the purchase, which must be paid for**).

13. In regard to **claims 56, 61, 67, and 72**, **Saxon** discloses a system for acquiring an inventor of sophisticated office machines comprising:

a needs analyzer, the needs analyzer further includes a needs receiver, the needs receiver is capable of receiving needs input by a consumer (**Page 1 ¶ 5 L. 1 – 12**),

wherein the needs analyzer analyzes the needs input by the consumer and converts said needs into a list of vendor specifications (**Page 1 ¶ 5 L. 1 – 12**),

a consultant interface, the consultant interface is capable of interacting with a consultant, the consultant interface is software couple to the needs analyzer wherein the consultant may review and modify the vendor specification list produced by the needs analyzer (**Page 1 ¶ 7 L. 11 – 13**).

14. In regard to **claims 57, 59, 62, 64, 68, 70, 73, and 75**, **Saxon** discloses further including a vendor quote requester wherein the vendor quote requester converts the list of vendor specifications into vendor-specific requests for quotations and prepares input screens reflecting each request for quotation (**Page 1 ¶ 5 L. 12 – 20**).

15. In regards to **claims 58, 60, 63, 65, 69, 71, 74, and 76**, **Saxon** is discussed above, but fails to teach further including a vendor interface, wherein one or more vendors review the requests for quotations and prepare and submit bids in response to said requests for quotations.

However, Keane teaches that the customer, whom instructs the system to search for printing firms to fulfill the customer's request (bidding), inputs predetermined requirements into the system. It would have been obvious that in the event that multiple

bidders are able to fulfill the predetermined requirements set by the customer that the system would require user input, by the customer, to make the final decision of who should carryout the request (Pg. 5 ¶ 52 L. 2 – 4, ¶ 55 L. 1 – 7).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Saxon in view of the teachings of Keane to include a vendor interface at the remote stations in order to have the vendors submit bids.

Response to Arguments

16. Applicant's arguments with respect to **claims 1 - 46** have been considered but are moot in view of the new ground(s) of rejection.

Objections towards drawings

17. Objections made towards the drawings have been withdrawn due to amendments.

Pertinent arguments

18. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., monitoring the sophisticated equipment after a purchase has been made) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

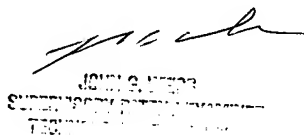
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GA
12/20/06



A handwritten signature in black ink is positioned above a rectangular official stamp. The stamp contains the text "JOHN A. HARRIS" in a bold, sans-serif font, with "UNITED STATES PATENT AND TRADEMARK OFFICE" printed in smaller text below it.